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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,506	05/25/2001	Ghita Lanzendorfer	BEIERSDORF70	8673

7590 02/26/2003

Norris McLaughlin & Marcus
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,506

Applicant(s)

LANZENDORFER ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,13,14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,13,14 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 8-9, 13-14, 16-23 are pending. The Amendment filed 12/18/02, Paper No. 10, amended claims 8-9, 20, cancelled claims 10-12 and 15, and added claims 21-23.

Response to Arguments

Regarding the 35 USC 102 rejections, the Applicant states, "Given the amendments made to the claims, it is believed that the examiner's previous rejections have been rendered moot".

The Applicant's Amendment and arguments filed 12/18/02, Paper No. 10, are persuasive in part to overcome the 35 USC 112 rejections in the previous Office Action. See below for details.

The Applicant's arguments filed 12/18/02, Paper No. 10, are sufficient to overcome the 35 USC 132 objection to the specification and the objection to Applicant's claim for foreign priority.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 13-14, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 9 is vague and indefinite, as it is confusing. Are not antioxidants, UVA and UVA filter substances, and inorganic pigments, cosmetic and dermatological auxiliaries? Why are antioxidants listed twice in the Markush group? What are UVA/UVB filter substances? Is such a substance anything that screens sun, such as hats or blankets?

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(ii) Claims 13 and 14 recites the limitations "deoxycholic acid, ursodeoxycholic acid, taurocholic acid" and "esters of bile acids and ethers of bile acids", respectively. There is insufficient antecedent basis for this limitation in the claim.

(iii) The rejection of claim 18, as being vague and indefinite is maintained. Applicant argues, "The examiner appears to believe that these two limitations are mutually exclusive. This is incorrect. This is an additional limitation upon the type of encapsulation form". This argument is not persuasive. Both claim 16 and claim 18, recite, "wherein the preparation is in _____ form". Thus, both claims appear to recite the preparation of claim 8 in the form of a solution and in an encapsulated form. This rejection can be overcome by amended claim 18 to read, "wherein the encapsulate form is in solution form".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-9, 13 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Caserio et al. (4,664,910).

Caserio et al. teach a cosmetic composition for topical application to the skin, which comprises 0.1-20% sodium desoxycholate, 5-99.9% of a powder absorbent, and 10-90% water. See Col. 8, lines 50-67. Thus, Caserio et al. and the instant invention both teach a composition comprising 0.1-0.5% sodium desoxycholate and cosmetic auxiliary for application to the skin.

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While the reference does not explicitly state a method of strengthening the barrier function of the skin comprising a barrier strengthening effective amount, the composition of the reference inherently has this property, as a compound and its properties are inseparable (In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)), and the reference teaches a composition comprising the effective amounts recited in the instant claim, and a method of applying the composition to the skin.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caserio et al. as applied to claims 8-9, 13 and 19-20 above, and further in view of Lyon et al. (4,115,313).

Caserio et al. is applied as discussed above. The reference lacks ester forms of the acids.

Lyon et al. teach bile acid emulsions for use in cosmetics. The bile acids include deoxycholic acid and can be in their ester forms in which the carboxyl group will be esterified with methanol or ethanol or other lower alcohols. Such derivitization is disclosed as producing bile acids active agents that have the advantage of being water soluble to varying degrees and capable of exerting a powerful detergent action. See Col. 2, lines 1-line 25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the sodium desoxycholate of Caserio et al. in the form of an ester, as taught by Lyon et al., because of the expectation of achieving a composition in which the bile acid is

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highly soluble in water and exerts a powerful detergent action to the skin, thereby removing more sebum and sweat.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caserio et al. as applied to claims 8-9, 13 and 19-20 above, and further in view of Tisdale et al. (6,103,246).

Caserio et al. is applied as discussed above. The reference lacks encapsulated forms.

Tisdale et al. teach that liposomes penetrate into the deep underlying layers of the skin where they deliver their active agents in a time-release action. Liposomes are encapsulated preparation forms. See Col. 2, lines 38-59.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the composition of Caserio et al. in the form of liposomes, as taught by Tisdale et al. because of the expectation of achieving a cosmetic composition with enhanced skin penetration and thus, effectiveness.

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caserio et al. as applied to claims 8-9, 13 and 19-20 above, and further in view of Pittrof et al. (5,376,646).

Caserio et al. is applied as discussed above. The reference lacks tocopherol acetate.

Pittrof et al. teach topical preparations containing the salt of a cholanic acid and a lipid for cosmetic use. Exemplified is a 2% tocopherol acetate mixed micelle solution comprising sodium glycocholate for topical use. See Col. 6, line 60-Col. 7, line 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the tocopherol acetate taught by Pittrof et al. to the composition of Caserio et al. because Caserio et al. teach that antioxidants can be added to their composition and Pittrof et al. teach tocopherol acetate as an antioxidant that can be combined with bile acid salts; thus, one of

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skill in the art would be motivated to look to Pittrof et al. for antioxidants that are combinable with bile acid salts.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

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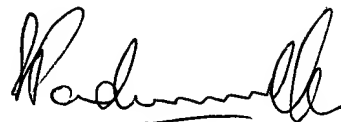
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

February 24, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

2/24/03